

REMARKS

Claims 1-70 are pending in the application. Claims 1-44 and 54-62 have been withdrawn as being directed to a non-elected invention. Applicant reserves the right to continue the prosecution of the non-elected inventions in one or more separately filed divisional patents without prejudice or disclaimer. Claims 45-53 and 63-70 have been rejected.

The Examiner rejected Claims 45-47, 68, and 70 under 35 U.S.C. § 103 as being obvious over Kaye, U.S. Patent No. 5,390,819 ("the Kaye Patent"). The Examiner also rejected Claims 48-53 under 35 U.S.C. § 103 as being obvious over the Kaye Patent in view of James, U.S. Patent No. 2,415,012 ("the James Patent"). In addition, the Examiner rejected Claims 63-68 under 35 U.S.C. § 103 as being obvious over the Kaye Patent. Applicant respectfully traverses these rejections on the basis of the arguments previously submitted in the Notice of Non-Compliant Amendment and Response to Office Action filed on January 25, 2006 and the following additional arguments in support of patentability.

There is absolutely no suggestion or teaching of any type that the stack of flexible sheets disclosed in the Kaye Patent could be utilized as a toy. To the contrary, the stack of flexible sheets disclosed in Kaye is used solely in combination with a **dispenser** that houses the sheets in a compact flat configuration. See, Kaye Patent, Col. 4, lines 31-36 ("since the ultimate object is to improve the ability of the separated sheets to lie flat during use, the corner placement of the adhesive in the sheets of the invention is superior to the edge band placement of the adhesive in the sheets of the prior art shown in FIG. 6."). As such, it is not possible to use the stack of flexible sheets as a toy, nor is there any suggestion that this stack of sheets could be utilized as a toy. Notwithstanding this fact, the Examiner baldly asserts that it would be obvious to use the stack of flexible sheets shown in Kaye as a recreational toy. The Examiner does not provide any evidence to support that conclusion, but instead relies upon a subjective hindsight analysis:

As shown in FIGs. 4 and 6, the stack can be spread into an accordion-forming shape, **which would provide for amusement to the user and, hence, would function a toy [sic]**. Contrary to Applicant's argument that FIGs. 4 and 6 of Kaye do not teach a recreational toy, the above explanation apply *a fortiori* herein. Once this stack is expanded or spread into such shape as FIGs. 4 and 6 of Kaye, **it would obviously amuse the user by drawing the user's attention thereto.** (emphasis added)

The Court of Appeals for the Federal Circuit has made clear that these type of conclusory statements regarding the motivation provided by the prior art are not sufficient to support a finding of obviousness:

This factual question of motivation is material to patentability, and could not be resolved on **subjective belief and unknown authority. IT is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'** W.L. Gore v. Garlock, Inc. 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

In re Sang Su Lee, 277 F.3d 1338, 1343, 61 U.S.P.Q. 2d 1430, 1434 (Fed. Cir. 2002).

Instead, a finding of obviousness "must be based on objective evidence of record." Id. at 1343, 1433.

The record establishes that FIGs. 4 and 6 are for purposes of illustrating how the adhesive of the prior art (FIG. 4 – adhesive on the edges) and of the invention of the Kaye Patent (FIG. 6 – adhesive on the corners) differ in terms of the location of the adhesive. The sheets are shown in expanded form because the location of the adhesive could not be illustrated when the sheets are in their normal stacked position for use in the dispenser. The Kaye Patent makes clear that this is the intention or purpose of showing the stack of sheets in expanded form, and there is no reason to believe that one in the art viewing these figures in the context of the Kaye Patent would believe that the sheets could function as a toy. See, Col. 4 lines 20-36 for the discussion of FIGs. 4 and 6 within the Kaye Patent.

The Examiner also argues that forming of the semi-circular arcuate shape as required in claim 70 would have been an obvious design choice modification of the shape. Again, this is a purely conclusory hindsight assessment. The stack of sheets in Kaye are intended to lie flat within a dispenser. There is no suggestion that they would be used as a toy and further no suggestion that the sheets would be expanded outside of the dispenser to result in any shape, much less an arcuate shape.

The Examiner further argues that the higher peel strengths required by claims 63-68 would have been an obvious optimization through routine experimentation in order to hold the sheets together in a stack. This is based upon the incorrect premise that Kaye teaches or suggests use of a higher peel strength. There is no basis for that assertion. Instead, Kaye specifically indicates that a "low tack repositionable adhesive" be utilized. (See column two, lines 66-67.) The Kaye Patent actually teaches away from utilizing a high-strength peel adhesion strength. The only purpose in using the high strength peel adhesion strength is in order to keep the sheets together when being used as a toy, the lower tack is needed for use in the dispenser. There is no motivation to optimize the peel strength because there is no motivation in Kaye to use the stack of sheets as a toy.

As to claims 48-53, the Examiner relies upon the James Patent to show the various positions in which the stack of sheets may be placed during play. However, this presumes that the Kaye Patent suggests the use of the sheets as a toy. As discussed above, that is not the case. Given that Kaye does not suggest the use of the sheets as a toy, there is no motivation to combine Kaye with James.

In order to make out a prima facie case of obviousness, the Patent Office must (1) determine the scope and contents of the prior art, (2) ascertain the differences between the prior art and the claims in issue, (3) determine the level of skill in the art, and (4) evaluate any

evidence of secondary considerations. Thus, to establish a prima facie case of obviousness, three basic criteria must be met. First, each and every claim limitation must be taught or suggested by the prior art. Second, there must be some suggestion or motivation to one skilled in the art to modify the references or to combine their teachings. Lastly, there must be a reasonable expectation of success in combining the references to achieve the claimed combination. Equally important, to support combining references, evidence of a suggestion, teaching or motivation to combine must be **clear and particular**, and this requirement for clear and particular evidence is not met by broad conclusory statements about the teaching of the references. In re Dembiczak, U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). There must be particular evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, **would have selected these components for combination in the manner claimed**. In re Kotzab, 55 U.S.P.Q.2d 1313, 13717 (Fed. Cir. 2000).


A prima facie case of obviousness had not been made as to the subject claims. There is nothing in either the Kaye Patent or the James Patent – either alone or in combination –that would teach or suggest using a stack of flexible sheets as a recreational toy. Applicant respectfully submits that when motivated to provide a toy for amusement to the user, one skilled in the art would not be motivated to look to office products, such as repositionable adhesive notes as disclosed in the Kaye Patent. That is, "the combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness." In re Oetiker, 997 F.2d 1443, 1445 (Fed. Cir. 1992).

In view of the foregoing remarks, it is respectfully submitted that the claims are now in condition for allowance and eventual issuance. Such action is respectfully requested. Should the

Examiner have any further questions or comments that need be addressed in order to obtain allowance, he is invited to contact the undersigned attorney at the number listed below.

Acknowledgement of receipt is respectfully requested.

Respectfully submitted,

By: 
Penny R. Slicer, Reg. No. 34,017
STINSON MORRISON HECKER LLP
1201 Walnut Street, Suite 2900
Kansas City, MO 64106-2150
Telephone: (816) 842-8600
Facsimile: (816) 691-3495
Attorney for Applicant